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OFFICE OF PETITIONS

In re Application of :
Rocky Stewart, Pal Takacs-Nagy, Timo :
Metasportti, and Michael Hyndman :
Application No. 09785,687 :
Filed: February 16, 2001 :
Attorney Docket No. BEAS-01033US :
Title: MESSAGE ROUTING SYSTEM :
FOR ENTERPRISE WIDE ELECTRONIC :
COLLABORATION :

DECISION REFUSING STATUS
UNDER 37 C.F.R. §1.47(a)

This is in response to the petition under 37 CFR §1.47(a)¹, filed July 23, 2001.

The petition under 37 C.F.R. §1.47(a) is **DISMISSED**.

Rule 47 applicant is given **TWO MONTHS** from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 C.F.R. §1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 C.F.R. §1.136(a).

The above-identified application was filed on February 16, 2001. On March 21, 2001, applicant was mailed a "Notice to File Missing Parts of Nonprovisional Application - Filing Date Granted" (Notice), requiring an executed oath or declaration in compliance with §1.63 and the surcharge for its late filing. This Notice set a two-month period for reply.

¹ A grantable petition under 37 C.F.R. §1.47(a) requires:

- (1) the petition fee of \$130;
- (2) a surcharge of either \$65 or \$130 if the petition is not filed at the time of filing the application;
- (3) a statement of the last known address of the non-signing inventors;
- (4) proof that diligent efforts have been made to locate the non-signing inventor;
- (5) a declaration which complies with 37 CFR 1.63.

In reply, applicant filed the instant petition (and fee). Accompanying the petition was a two-month extension of time, a declaration executed by three of the four inventors, as well as a declaration by the petitioner that sets forth that two e-mails were sent on April 17, 2001 and April 24, 2001, to the non-signing inventor at his work address, requesting his signature on the declaration. After no response was received, the petitioner learned that the non-signing inventor was no longer employed by the assignee. On April 27, 2001, the petitioner sent the relevant documents to the last known home address of the inventor², where an Irene Summanen signed for them³. On May 23, 2001 and on June 6, 2001, the petitioner telephoned the non-signing inventor at his last known telephone number⁴, only to learn that the telephone number was invalid.

Rule 47 applicant has met requirements (1), (2), (3), and (5) above.

Regarding requirement (4) above, it is determined that the Rule 47 applicant has failed to show that the non-signing inventors refused to sign the declaration after having been presented with the application papers. Before a refusal can be alleged, applicant must demonstrate that a *bona fide* attempt was made to present a copy of the application papers to each non-signing inventor⁵.

Petitioner has not shown that the non-signed inventors cannot be reached or located after diligent effort. The petitioner sent the relevant documents to the non-signing inventor's residence in Finland, and an unknown person accepted the package. The petitioner then telephoned the non-signing inventor at this same address, only to find that the telephone number was no longer valid. Both of these events would indicate to the average person that the non-signing inventor no longer resided at this address, and yet no attempt was made to locate the present whereabouts of the non-signing inventor. Furthermore, even though an alternate address is listed on the declaration submitted with the instant petition, no mention is made of any attempt to contact the non-signing inventor at this California listing.

As these seemingly obvious steps were not taken, these actions, by themselves, do not constitute a diligent search. There is no indication that Rule 47 applicant attempted to verify the inventor's addresses or, if appropriate, to determine his forwarding addresses, and to send the application papers to those addresses for consideration by the inventor⁶. If diligent efforts to obtain a forwarding address or to locate the non-signing inventor by other means such as through E-mail, telephone, or the Internet continue to fail, then

² Unfortunately, a copy of the FedEx label was not included with the present petition, and the included e-mail receipt from Fed Ex does not include the shipping address. Furthermore, the hypertext link to the FedEx Website found on the receipt is no longer valid, and the information is no longer accessible from the Website. The declaration lists the residence of the non-signing inventor as being in Finland, and the Post Office address as being in California. Since the declaration states that the packages were sent to the "last known home address", it will be assumed that these were sent to the address in Finland.

³ The identity of this person, as well as her relationship to the non-signing inventor, appears to be unknown.

⁴ This is again assumed to be at his address in Finland.

⁵ See MPEP 409.03(d).

⁶ See MPEP 409.03(d).

applicant will have provided the necessary proof required under 37 C.F.R. §1.47 that the inventor cannot be reached. Details of the efforts to locate the non-signing inventor should be set forth in an affidavit or declaration of facts by a person with first hand knowledge of the details. Applicant should submit documentary evidence such as the results of an E-mail or Internet search.

On renewed petition, the petitioner should either provide the signatures of the non-signing inventors, or provide a showing that a diligent search has been undertaken, and has failed to secure the signature of Mr. Metasportti.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
Arlington, VA

Telephone inquiries regarding this decision should be directed to Petitions Attorney Paul Shanowski at (703) 305-0011.



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